

REMARKS

This is a response to the office action mailed May 5, 2011. In the office action the Examiner:

- rejected claims 1, 4-7, and 14-18 as being anticipated in light of Infosino (US Pub 2002/0034280);
- rejected claim 2 as being obvious in light of Infosino (US Pub 2002/0034280) when read together with Wieczorek (EP 1271911);
- rejected claim 8 as being obvious in light of Infosino (US Pub 2002/0034280) when read with Parsons (US Pub 2002/0085701); and
- claims 3, 9-13 and 19 as being obvious in light of Infosino (US Pub 2002/0034280) when read along with Guibourge (US Pub 2004/0119755).

Amendments to Claims

Claim 1 has been amended. Support is provided at least in paragraphs [0033] and [0047] to [0055] of the application as published.

Claim 2 has been canceled and rewritten as new claim 20.

Claims 3-11, and 13-18 have been amended. Support is provided at least in paragraphs [0011] to [0017], [0020] to [0023], [0027], [0047], [0050], and [0062] to [0082] of the application as published.

Claim 19 has been canceled.

Claims 21-38 have been added.

No new matter has been added.

Interview Summary

An interview was held on Tuesday, August 2, 2011 with the Examiner and Applicant representatives Craig Opperman and Linda Lee. The Examiner is thanked for the opportunity to

discuss this application and the Office Action. The Examiner's time and attention is much appreciated.

During the interview the differences between the Infosino reference and the present application were discussed. Proposed amendments to claim 1 were discussed. The Examiner was willing to consider allowance if dependent claims 9, 10, and 11 were incorporated into claim 1. Applicant representatives indicated that they would consider the proposal by the Examiner.

ARGUMENTS

In the Office Action, claims 1, 4-7, and 14-18 have been rejected as being anticipated in light of Infosino (US Pub 2002/0034280, hereinafter "Infosino").

As shown below, however, the claims have been amended to overcome this rejection.

Rejection under 35 USC 102(b)

It is well established that a patent application's "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." MPEP § 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Similarly, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Infosino reference does not teach the claimed invention.

Specifically, amended claim 1 recites, in part:

...receiving a command signal during a call connect
process...

in response to receiving the command signal, initiating a
service or transaction between the caller and the call recipient other

than a standard call connection transaction, without connecting the caller through to the call recipient and wherein the command signal is received from a communication device of the caller.

Thus the claim requires (a) “in response to receiving the command signal, initiating a service or transaction between the caller and the call recipient,” (b) the service or transaction is “other than a standard call connection transaction,” and (c) “without connecting the caller through to the call recipient.” Claim 21 includes similar limitations.

For a number of reasons each set out below, the Infosino reference fails to teach at least these elements of amended claim 1 and new claim 21.

In contrast to claim 1, Infosino concerns only the caller while on the caller device

Infosino does not teach “initiating a service or transaction between the caller and the call recipient,” in response to receiving a command signal. Instead, Infosino teaches automatically setting specific communication “parameters” (settings like volume, whether call waiting is enabled, and so on) on a user device for an individual user, based on that user’s profile.¹ Settings can be made locally at the client device or centrally.² One way of identifying the user is by recognizing the voice of the calling or called party.³

Infosino is only concerned with changing settings of a user’s own device. Thus, any service provided is solely to the caller while on the caller’s device. The focal point of Infosino is therefore customized parameters on the caller device. For example, FIG. 3 of Infosino shows a user profile data structure listing a single device identifier, e.g., a telephone number, associated with several registered users of that one device. The system changes the settings on the device each time any of the registered users makes a call on the same device.⁴ The system does not anticipate any services to a call recipient based on a command signal entered by the caller. Thus,

¹ See, for example, Infosino paragraphs [0020] to [0025]

² See, for example, Infosino paragraph [0041] and [0042]

³ See, for example, Infosino paragraph [0038]

⁴ See, for example, Infosino paragraphs [0008], [0032], and [0033]

Infosino does not teach anything about providing a transaction between a caller and a call recipient.

Since the Infosino system provides caller specified phone settings for the caller on the used device, there is no requested service between caller and call recipient in Infosino. Therefore, Infosino does not teach this specific element of amended claim 1.

Infosino does not teach “other than a standard call connection transaction”

Infosino also does not teach a service or transaction that is “other than a standard call connection transaction.” The communication settings in Infosino are “used to set communication parameters for users using a shared telephony device.”⁵ In other words, setting the custom parameters results in the user making a standard call connection.

Since the services in Infosino results in a standard call connection between a caller and a call recipient, Infosino fails to teach this specific element.

Infosino also does not teach “without connecting the caller through to the call recipient”

Furthermore, Infosino’s teaching does not include initiating any service or transaction “without connecting the caller through to the call recipient.” In contrast, Infosino is predicated on connecting the caller to the call recipient. Infosino provides a service for customizing communication parameters on a shared calling device when the user uses the device to make a call.⁶ In fact, in all the examples described by Infosino, setting communication parameters on the caller device results in nothing other than the caller completing a standard communication to a call recipient.⁷

Thus, Infosino does not teach initiating a service or transaction “without connecting the caller through to the call recipient.”

⁵ See, for example, Infosino paragraph [0005]

⁶ See, for example, Infosino paragraph [0005]

⁷ See for example, Infosino paragraphs [0038] and [0039]

Since Infosino does not teach all the elements of amended claim 1, Infosino does not anticipate the claimed invention. For at least the same reasons above, Infosino also does not teach all the elements of new claim 21.

Claims that depend from an allowable independent claim are allowable at least for the same reasons. Dependent claims 2-4 and 8-13, which are rejected under 35 USC 103(a), now depends from allowable independent claim 1, and should be allowed for at least the same reasons above. Therefore, claims 1 and 3-18 are patentable over Infosino or in combination with one or more of the additionally cited references. Since the newly added claims 20-38 include the same or similar limitations, they too are allowable.

CONCLUSION

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards expeditious allowance. The Examiner is invited to call the undersigned attorney at (650) 352-0524, if a telephone call could help resolve any remaining items.

Date: August 12, 2011

Respectfully submitted

Reed Smith LLP

/Craig P. Opperman/

Craig P. Opperman, Reg. No. 37,078

Reed Smith LLP

P.O. Box 488

Pittsburgh, PA 15230-0488

copperman@reedsmith.com